

### **Remarks**

Claims 1-20 are pending.

We gratefully acknowledge the Examiner's indication that claims 7, 12, and 16 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### **§ 103 Rejections**

The Examiner has rejected claims 1, 2, 4, 6, and 8-10 under 35 USC § 103(a) as being unpatentable over U.S. Patent 3,637,181 to Janssen in view of U.S. Patent 4,606,666 to Patton.

Janssen describes a fixture or hanger with reference to Figure 5 that, like the hanger according to the present invention as claimed in claim 1, includes a base (33) having a supported surface adapted to be positioned along a generally vertical surface, and an opposite outer surface; an elongate peg (34) having a longitudinal axis and first and second longitudinally spaced ends, a portion of which peg adjacent its first end is mounted on the base in a use position with the axis of the peg projecting away from the supported surface, at least a major portion of which peg adjacent its second end projects from the outer surface of the base. Also, the peg described in Janssen has an axially extending surface portion adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface.

Unlike the paper hanger according to the present invention, however, the fixture or hanger described by Janssen is "useful when it is desired to mount shelves or racks on concrete, cement or other masonry-type walls and surfaces where it is extremely difficult to drive nails or bolts in the masonry material" (column 3, lines 37 to 40 of Janssen). "After the fixtures have been bonded to a wall or other surface, boards or panels may be mounted thereon by forcing the boards or panels onto the protruding nail." (column 3, lines 42 to 44 of Janssen).

In contrast, the paper hanger according to the present invention as claimed in claim 1 is for supporting one or more sheets of paper, the major portion of the peg on which the paper sheets are supported has a diameter of less than about 0.17 inch (0.43 centimeter), and an axially extending surface portion of the peg adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface is adapted to restrict free movement of

sheets of paper around the peg axially of the peg. It would not have been obvious to one skilled in the art of hangers to adapt a hanger for shelves or racks of the type described by Janssen for the purpose of making a paper hanger by providing those features.

There is no teaching or suggestion in Janssen to use his peg to support sheets of paper, nor to provide a peg for supporting the sheets of paper that has a major portion with a diameter of less than about 0.17 inch (0.43 centimeter), and has an axially extending surface portion of the peg adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface that is adapted to restrict free movement of sheets of paper around the peg axially of the peg.

The Examiner has acknowledged these differences between the paper hanger according to the present invention and the hanger described by Janssen both in her comments and by citing Patton.

Patton describes a paper binder for retaining loose paper sheets in assembled and stacked relation. The binder includes a base strip (14) having a plurality of spaced upstanding pegs (18) integral therewith, which pegs have peripheral serrations (22). The pegs extend through apertures in the paper sheets and also extend through apertures in a clamping strip (24) which clamping strip (24) engages the upper surface of the top paper sheet. At each aperture the clamping strip (24) has a tongue (30) which engages the peg (18) therein under its serrations to lock the clamping strip (24) in a clamped position against the top paper sheet.

There is no teaching or even a remote suggestion in Patton to substitute one of the pegs (18) used in the paper binder he describes for the nail described by Janssen to form a paper hanger like that claimed in claim 1 that has an axially extending surface portion adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface, with only the axially extending surface portion of the peg being adapted to restrict free movement of sheets of paper around the peg axially of the peg.

Janssen describes a hanger intended for shelving or the like, whereas, Patton describes a portable paper binder. These are structures from unrelated fields of art, nether of which have anything to do with hangers for sheets of paper. The base strip (14) from which the pegs (18) in the binder described by Patton project can be, but are not normally intended to be positioned

along a generally vertical surface. The clamping strip (24) along the upper surface of the top paper sheet in the binder of Patton engages the peg (18) to hold the sheets on the peg (18). Thus there is no teaching or suggestion from the binder described by Patton that only the serrations on peg (18) could restrict free movement of sheets of paper around the peg axially of the peg should the peg be used on a paper hanger of the type claimed. The Examiner's obviousness conclusion lacks the requisite suggestion for the proposed modifications as well as the requisite reasonable expectation that the proposed modifications would be successful. See In re O'Farrell, 853 F.2<sup>nd</sup> 846, 850-51, 7 USPQ2<sup>nd</sup> 1673, 1680-81 (Fed. Cir. 1988). It is only the Applicant's own disclosure that provides any teaching or suggestion for the combination of structural features recited in claim 1. The Examiner's obviousness conclusion is based upon impermissible hindsight rather than upon some teaching suggestion or incentive derived from the applied prior art. Thus, the structure for a paper hanger recited in claim 1 is not made obvious by Janssen in view of Patton.

Claim 1 should be allowed.

Claims 2, 3, 4, 5, 6, and 8-10 are dependent on claim 1, and thus are allowable for all of the reasons given above with respect to claim 1. Additionally, these dependent claims include further structural limitations that are not shown or suggested in the claimed combination by Janssen or Patton. For example, claim 2 recites that the axially extending surface portion of the peg defines closely spaced sharp edges that are adapted to restrict free movement of sheets of paper around the peg axially of the peg which sharp edges claim 3 recites are defined by machine screw threads extending around the axis of the peg; which sharp edges claim 5 recites are provided by a coating of abrasive granules; and which sharp edges claim 6 recites are provided by axially spaced transverse ridges only on the axially extending surface portion. Claim 9 recites that a major portion of the peg adjacent its second end projects from the outer surface of its base by a distance in a range of about 0.15 to 0.30 inch (0.38 to 0.76 centimeter); whereas claim 10 recites that feature together with the feature that the peg has a diameter of about 0.11 inch (0.28 centimeter). Such dimensions are not suggested by either the hanger of Janssen or the binder of Patton.

The Examiner has rejected claim 5 under 35 USC § 103(a) as being unpatentable over Janssen combined with Patton in view of U.S. Patent 2,866,583 to Batts and further in further view of U.S. Patent 5, 690,561 to Rowland et al. As noted above, there is no teaching or suggestion in either Janssen or Patton to provide a paper hanger of the type claimed in claim 1 in which only an axially extending surface portion of the peg that is adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface is adapted to restrict free movement of sheets of paper around the peg axially of the peg. Also, Batts does not suggest such a paper hanger in which an axially extending surface portion on the peg is coated with abrasive granules to restrict free movement of sheets of paper around the peg axially of the peg because of sharp edges provided by the abrasive granules. Batts describes granules of a soft resilient material such as rubber (see col. 2, lns 31-36) on various types of clothes hangers to restrict slippage of clothes from around the hanger. Batts indicate that abrasive particles would not be useful for his purposes (see col. 5, lns 64-66). Rowland describes the use of sharp edges provided by serrations or abrasive granules on the face of a golf club to affect movement of a golf ball struck by the club. Janssen, Patton, Batts and Rowland describe structures from unrelated fields of art, none of which have anything to do with hangers for sheets of paper, and there is no teaching or suggestion in any of those references that would make obvious a paper hanger having the features for a paper hanger claimed in claim 5.

The Examiner has rejected independent claim 1 and claims 2-4, 9, and 10 dependent on claim 1 under 35 USC § 103(a) as being unpatentable over U.S. Patent 2,314,121 to Brennan in view of U.S. Patent 6,074,147 to Shu.

Brennan describes a paper hanger that, like the paper hanger according to the present invention as claimed in claim 1, includes a base (16) having a supported surface adapted to be positioned along a generally vertical surface, and an opposite outer surface; an elongate peg (19) having a longitudinal axis and first and second longitudinally spaced ends, a portion of which peg adjacent its first end is mounted on the base in a use position with the axis of the peg projecting away from said supported surface, at least a major portion of which peg adjacent its second end projects from the outer surface of the base. Also, the peg described in Brennan has a generally uniform cross sectional area along its length and an axially extending surface portion

adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface.

Unlike the paper hanger according to the present invention as claimed in claim 1, however, it can not be said that only that axially extending surface portion of the peg (19) described by Brennan is adapted to restrict free movement of sheets of paper around the peg axially of the peg. Rather, Brennan uses a clamp (24) that has a tongue (23) adapted to engage one of several spaced openings (22) along the peg (19) to restrict free movement of sheets of paper around the peg axially of the peg.

The Examiner has acknowledged differences between the paper hanger according to the present invention and the paper hanger described by Brennan by citing Shu.

Shu describes a tamper proof seat screw (30) that can be used as an idle screw for a throttle lever of a throttle body. There is no teaching or even any remote suggestion in Shu to substitute that seat screw (30) for the peg (19) described by Brennan to form a paper hanger like that claimed in claim 1 that has an axially extending surface portion adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface, with only the axially extending surface portion of the peg being adapted to restrict free movement of sheets of paper around the peg axially of the peg.

While Brennan describes a paper hanger, the tamper proof set screw (30) described by Shu is intended to be used in mechanical devices (e.g., as an idle screw for a throttle lever of a throttle body) to provide a set screw that is difficult to tamper with after it has been placed in a desired position. This is a structure from a field of art that is totally unrelated to the field of hangers for sheets of paper. There is no teaching or even any remote suggestion in Shu to substitute his set screw for the peg of Brennan so that the screw threads on the set screw could restrict free movement of sheets of paper around the set screw axially of the set screw should the set screw be used on a paper hanger of the type claimed. This is so even if the set screw described by Shu has a size included in the dimensional limitations noted by the Examiner. The Examiner's obviousness conclusion lacks the requisite suggestion for the proposed modifications as well as the requisite reasonable expectation that the proposed modifications would be successful. See In re O'Farrell, 853 F.2<sup>nd</sup> 846, 850-51, 7 USPQ2<sup>nd</sup> 1673, 1680-81 (Fed. Cir.

1988). It is only the applicant's own disclosure that provides any teaching or suggestion for the combination of structural features recited in claim 1. The Examiner's obviousness conclusion is based upon impermissible hindsight rather than upon some teaching suggestion or incentive derived from the applied prior art. Thus, the structure for a paper hanger recited in claim 1 is not made obvious by Brennan and Shu.

Claim 1 should be allowed.

Claims 2-4, 9, 10 are dependent on claim 1, and thus are allowable for all of the reasons given above with respect to claim 1. Additionally, these dependent claims include further structural limitations that are not shown or suggested in the claimed combination by Brennan or Shu. For example, claim 2 recites that the axially extending surface portion of the peg defines closely spaced sharp edges that are adapted to restrict free movement of sheets of paper around the peg axially of the peg which sharp edges claim 3 recites are defined by machine screw threads extending around the axis of the peg; and which sharp edges claim 4 recites are provided by serrations on the peg. Claim 9 recites that a major portion of the peg adjacent its second end projects from the the outer surface of its base by a distance in a range of about 0.15 to 0.30 inch (0.38 to 0.76 centimeter); whereas claim 10 recites that feature together with the feature that the peg has a diameter of about 0.11 inch (0.28 centimeter). Such dimensions are not indicated by either the sheet hanger of Brennan or the set screw of Shu.

The Examiner has also rejected independent claim 13 and claims 14, 15, and 17-20 dependent on claim 13 under 35 USC § 103(a) as being unpatentable over Brennan in view of Shu.

Brennan describes a combination including a stack of paper and a paper hanger that, like the combination according to the present invention as claimed in claim 13, includes a paper hanger including a base (16) having a supported surface adapted to be positioned along a generally vertical surface, and an opposite outer surface; an elongate peg (19) having a longitudinal axis and first and second longitudinally spaced ends, a portion of which peg adjacent its first end is mounted on the base in a use position with the axis of the peg projecting away from the supported surface, at least a major portion of which peg adjacent its second end projects from the outer surface of the base. Also, the peg described in Brennan has a generally uniform

cross sectional area along its length and an axially extending surface portion adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface.

Unlike the paper hanger in the combination according to the present invention as claimed in claim 13, however, it can not be said that only that axially extending surface portion of the peg (19) described by Brennan is adapted to restrict free movement of sheets of paper around the peg axially of the peg, or that the axially extending surface portion of the peg (19) described by Brennan has closely spaced sharp edges. Rather, Brennan uses a clamp (24) that has a tongue (23) adapted to engage one of several spaced openings (22) along the peg (19) to restrict free movement of sheets of paper around the peg axially of the peg.

The Examiner has acknowledged differences between the paper hanger according to the present invention and the paper hanger described by Brennan by citing Shu.

Shu describes a tamper proof set screw (30) that can be used as an idle screw for a throttle lever of a throttle body. There is no teaching or even any remote suggestion in Shu to substitute that set screw (30) for the peg (19) described by Brennan to form a paper hanger like that claimed in claim 1 that has an axially extending surface portion adapted to be positioned uppermost when the supported surface is positioned along a generally vertical surface which surface portion defines closely spaced sharp edges, with only the sharp edges along the axially extending surface portion of the peg restricting free movement of sheets of paper around the peg axially of the peg.

As noted above with respect to claim 1, while Brennan describes a paper hanger, the tamper proof set screw (30) described by Shu is intended to be used in mechanical devices (e.g., as an idle screw for a throttle lever of a throttle body) to provide a set screw that is difficult to tamper with after it has been placed in a desired position. This is a structure from a field of art that is totally unrelated to the field of hangers for sheets of paper. There is no teaching or even any remote suggestion in Shu to substitute his set screw for the peg of Brennan so that the screw threads on the set screw could restrict free movement of sheets of paper around the set screw axially of the set screw should the set screw be used on a paper hanger of the type claimed. This is so even if the set screw described by Shu has a size included in the dimensional limitations noted by the Examiner. The Examiner's obviousness conclusion lacks the requisite suggestion

for the proposed modifications as well as the requisite reasonable expectation that the proposed modifications would be successful. See In re O'Farrell, 853 F.2<sup>nd</sup> 846, 850-51, 7 USPQ2<sup>nd</sup> 1673, 1680-81 (Fed. Cir. 1988). It is only the Applicant's own disclosure that provides any teaching or suggestion for the combination of structural features recited in claim 13. The Examiner's obviousness conclusion is based upon impermissible hindsight rather than upon some teaching suggestion or incentive derived from the applied prior art. Thus, the structure for a paper hanger recited in claim 13 is not made obvious by Brennan and Shu.

Claim 13 should be allowed.

Claims 14, 15, and 17-20 are dependent on claim 13, and thus are allowable for all of the reasons given above with respect to claim 13. Additionally, these dependent claims include further structural limitations that are not shown or suggested in the claimed combination by Brennan or Shu. For example, claim 14 recites that the sharp edges that restrict free movement of sheets of paper around the peg axially of the peg are defined by machine screw threads extending around the axis of the peg; claim 15 recites that those sharp edges are provided by serrations on the peg; and claim 18 indicates that those sharp edges are provided by axially spaced transverse ridges only on the axially extending surface portion. Claim 19 recites that a major portion of the peg adjacent its second end projects from the outer surface of its base by a distance in a range of about 0.15 to 0.30 inch (0.38 to 0.76 centimeter); whereas claim 20 recites that feature together with the feature that the peg has a diameter of about 0.11 inch (0.28 centimeter). Such dimensions are not indicated for the claimed combination by either the sheet hanger of Brennan or the set screw of Shu.

Reconsideration and allowance of all of the claims in the application are respectfully requested.

Respectfully submitted,

September 19, 2006

Date

By: William L. Huebsch

William L. Huebsch, Reg. No.: 25,990

Telephone No.: 651-733-2835

Office of Intellectual Property Counsel  
3M Innovative Properties Company  
Facsimile No.: 651-736-3833